crowell moring

P.O. Box 14300, Washington, DC 20044-4300 ▪ p202 624-2500 ▪ f202 628-8844
Courier Address: 1001 Pennsylvania Avenue, NW, Washington, DC 20004-2595

FACSIMILE COVER PAGE

Date: September 7, 2004

To: Examiner Victor L. MACARTHUR

Firm: US PTO

Facsimile Telephone Number: (703) 872-9306

Total Number of Pages (*Includes Cover Sheet*): 15

From: Song Zhu, Ph.D. **Phone:** (202) 624-2500

CAM Number: 056215.50809US **User ID:** 1350

Message: Re: ***Application Serial No. 10/030,818***

I hereby certify that an original of this Appeal Brief is being faxed to Examiner MACARTHUR at the U.S. Patent and Trademark Office (fax number: (703) 872-9306) on September 7, 2004.

Song Zhu, Ph.D.

Hard Copy to Follow: ☐ **Yes** ☒ **No**

RECEIVED
CENTRAL FAX CENTER
SEP 07 2004

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application No.	: 10/030,818	Confirmation No.	: 2416
Applicant	: Hans BRUDER		
Filed	: June 7, 2002		
TC/A.U.	: 3679		
Examiner	: Victor L. MACARTHUR		
Docket No.	: 056215.50809		
Customer No.	: 23911		
Title	: SUPPORTING PROFILE		

Mail Stop Appeal Brief-Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

APPEAL BRIEF

Sir:

On June 24, 2004, Appellant appealed to the Board of Patent Appeals from the final rejection of Claims 10-18. The following is Appellant's Appeal Brief submitted pursuant to 37 C.F.R. §1.192.

The Commissioner is authorized to charge the $330.00 appeal brief fee and any other requisite fees to the Deposit Account 05-1323 (CAM No. 056215.50809US).

Real Party in Interest

This application is assigned to Octanorm-Vertriebs-GmbH fuer Bauelemente of Filderstadt, Germany, which is the real party in interest in this appeal.

Related Appeals and Interferences

Applicant and his counsel are not aware of any related appeals or interferences which would affect, be affected by, or have a bearing on the instant appeal.

Status of Claims

Claims 10-18 are pending and under examination. Claims 10-18 are finally rejected and form the subject of this appeal.

Status of Amendments

There are no unentered amendments.

Summary of Invention

The invention is directed to a supporting profile (1) for erecting a structure. The supporting profile includes an elongated hollow body that has first and second ends and longitudinal grooves (2) on the outside of the elongated hollow body (see, for example, Figures 1, 7, and 9).

The profile (1) also includes an adapter piece (3) that is inserted into and secured to the first end of the elongated body (Figures 2, 4, and 10). The adapter piece (3) has a receiving chamber (23) for receiving a turnbuckle (Figures 2, 4, and 10).

The profile (1) further includes a disk-shaped end piece (5) that is disposed at the first end of the elongated hollow body and connected to the adapter piece (23) (Figures 2 and 3). The disk-shaped end piece (5) can be mounted on a face of the hollow body and can be fastened to the adapter piece (23) by fasteners (6) (Figure 2). The end piece (5) may have a concave recess (25) that is adapted to an external curvature of a round profile (1) (Figures 10-12). The end piece (5) may also have an opening (26) for the turnbuckle to pass through (Figures 11 and 12). The end piece (5) further can have a joint (9) for connection to another profile (Figures 2 and 5).

The joint (9) preferably includes a first disk (9) which extends perpendicular to the end piece (5) and has a center bore (10), and a second disk which has a center bore (10) (Figures 2 and 5). In a preferred embodiment, the second disk is connected with the first disk (9) by means of a bolt extending through the center bores (10) and acting as an axis of rotation (Figures 2 and 5). The second disk preferably has a fastening device for connection to another profile (Figures 2 and 5). The second disk may also have a clamping part (15, 16) that is configured for insertion into a longitudinal groove (2) of another supporting profile (Figures 2 and 5).

The supporting profile may further include first and second hemispheres (13) for covering two sides of the first and second disks (Figures 2 and 6). Each hemisphere has a

threaded center bore, by which the hemisphere is screwed onto a thread at an end of the bolt (11) penetrating the disks (Figures 2 and 6).

Rejections

Claims 10-16 stand rejected under 35 U.S.C. §102(b) as being anticipated by Monti (U.S. Patent 4,410,157).

Claims 17 and 18 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Monti in view of Summers (U.S. Patent 2,538,483).

Issues

The issues on appeal are as follows:

1. Whether Claim 10 requires that the disk-shaped end piece "belong to" the supporting profile when Claim 10 recites that the supporting profile comprises the disk-shaped end piece.

2. Whether the lower end cap of support member 14B in Monti is disk-shaped.

3. Whether the Examiner has fully and clearly stated why he believes that the threaded bore of Monti is capable of receiving a turnbuckle when the Examiner states only that the threaded bore "is fully capable of receiving a turnbuckle."

4. Whether the radiused [sic] end portion of the T-slot of Monti can be adapted via a T-bolt to the external curvature of a round profile when the radius of the end portion is much smaller than the radius of the round profile.

5. Whether Monti discloses that the clamping assembly is a part of the lower end cap of support member 14B.

6. Whether Monti discloses that the clevis portion of the clamping assembly extends perpendicular to the lower end cap of support member 14B.

7. Whether the combination of Monti and Summers teaches the use of two hemispheres to cover two sides of two disks.

Grouping of Claims

For the purpose of this appeal, Claims 10 and 12 stand or fall together; Claims 14-16 stand or fall together; and Claims 17 and 18 stand or fall together.

Argument

I. Claim 10 requires that the disk-shaped end piece "belong to" the supporting profile because Claim 10 recites that the supporting profile comprises the disk-shaped end piece

Claim 10 recites a supporting profile that includes an elongated hollow body, an adapter piece inserted into and secured to a first end of the elongated hollow body, and a disk-shaped end piece connected to the adapter piece, wherein the disk-shaped end piece is mounted on a face of the hollow body and is fastened to the adapter piece by fasteners.

In the Office Actions of November 3, 2003 and March 24, 2004, Claim 10 was rejected as being anticipated by Monti. Monti discloses a photography stand system that includes three support members (14A, 14B, 14C) (column 2, lines 1-3; and Figures 1 and 2). Each support member (14A, 14B, 14C) includes upper and lower end caps (46) (column 7, lines 41-43). Figure 3 shows the upper end cap (46) of one support member designated by reference numeral 14A, and the lower end cap (46) of another support member designated by reference numeral 14B. Monti specifies that each end cap (46) has a plug portion (48) that allows the end cap (46) to be inserted into the inside surface (50) and opposite slotted protuberance (24) (see the missing page of the Monti patent and Figure 3).

In rejecting Claim 10 as being anticipated by Monti, the Examiner contended that Figure 3 of Monti shows a supporting profile that comprises an elongated hollow body, an adapter piece, and a disk-shaped end piece. According to the Examiner, the adapter piece of Monti is the upper end cap (46) of the support member designated by reference numeral **14A**, and the disk-shaped end piece of Monti is the lower end cap of the support member designated by reference numeral **14B**.

In the Response to the Office Action of November 3, 2003, Applicant pointed out that the Examiner contended that Monti discloses a **(single)** supporting profile **(14A)** that includes a component (the lower end cap of the support member **14B)** which, according to Monti, does

not belong to this supporting profile (14A). In other words, Monti does not disclose a single supporting profile that includes both the upper end cap of the support member designated by reference numeral 14A, and the lower end cap of the support member designated by reference numeral 14B.

In the Office Action of March 24, 2004, the Examiner responded by first acknowledging Applicant's argument that "the component belongs to profile (14B) and does not belong to profile (14A)." But the Examiner argued that the limitation "belongs to" is not recited in the claim language. Applicant respectfully disagrees.

Claim 10 recites "a supporting profile...comprising...a disk-shaped end piece...." In other words, the supporting profile of Claim 10 comprises a disk-shaped end piece. This means that the disk-shaped end piece belongs to the supporting profile. Accordingly, it is incorrect for the Examiner to say that Claim 10 does not specify that the disk-shaped end piece belong to the supporting profile.

Applicant wishes to emphasize that Monti discloses three supporting members (14A, 14B, 14C), each of which includes an upper end cap and a lower end cap (column 7, lines 41-43). Monti does not disclose a supporting profile that includes components from two supporting members 14A and 14B. It is similar to the fact that a drawing showing two tables that each have four legs does not show one table with five legs (i.e. the combination of a four-legged table and a leg of another table). This is a well-established principle of patent law.

In view of the above discussion, Applicant respectfully submits that Claim 10 requires that the disk-shaped end piece "belong to" the supporting profile. Reversal of the rejection is respectfully requested.

II. The lower end cap of support member 14B in Monti is not disk-shaped

In rejecting Claim 10 as being anticipated by Monti, the Examiner contended that the element of Monti, which was designated by the Examiner with reference character "top 52" in the Office Action of November 3, 2003 and with reference numeral 200 in the Office Action of March 24, 2004, is a disk-shaped end piece. In Monti, this element is described as

the lower end cap of support member 14B and is designated by reference numeral 46 (see Figure 3 of Monti).

Applicant respectfully submits that the lower end cap (46) of support member 14B is not disk-shaped. Monti clearly states that each end cap (46) has a plug portion (48) that is integral with a face portion (52) (see the missing page of Monti and Figure 3). If anything, the end cap (46) has the shape of a cylinder.

Although the lower end cap (46) of support member 14B appears to be disk-shaped in Figure 3, it is clear from the description of the end caps (46) that the lower end cap (46) of support member 14B has a plug portion that is not shown in Figure 3.

It is also clear from Monti that whenever the portion of the lower end cap (46), which is shown in Figure 3, is attached to the upper end cap (46) of support member 14A, the plug portion (48) of the lower end cap (46) must also be attached to the upper end cap (46) of support member 14A. In other words, it is impossible to attach only the portion of the lower end cap (46), which is shown in Figure 3, to the upper end cap (46) of support member 14A without also attaching the plug portion (48). Therefore, Monti does not disclose a disk-shaped element being attached to the upper end cap (46) of support member 14A.

Consequently, Applicant respectfully requests reversal of the rejection of Claim 10, because Monti does not disclose a disk-shaped end piece attached to the upper end cap (46) of support member 14A.

III. The Examiner has not fully and clearly stated why he believes that the threaded bore of Monti is capable of receiving a turnbuckle

Claim 10 calls for an adapter piece having a receiving chamber for receiving a turnbuckle. An embodiment of the receiving chamber is described in the specification (page 7) and shown in Figures 4 and 10. An example of a turnbuckle that is to be received in the receiving chamber is also provided in the specification (page 7).

In rejecting Claim 10 as being anticipated by Monti, the Examiner contended that the threaded bore (66) of Monti (Figure 3) is capable of receiving a turnbuckle. Applicant

respectfully submits that the Examiner has not fully and clearly stated the reasons for this ground of rejection.

The Examiner contended that the receiving chamber of Claim 10 is anticipated by the threaded bore (66) of Monti, because the threaded bore (66) is capable of receiving a turnbuckle. However, the Examiner failed to provide *any reason* why he believed that the threaded bore (66) of Monti is capable of receiving a turnbuckle, let alone fully and clearly stating his reason as required by the MPEP. MPEP, §707.07(d), eighth edition, second revision (where a claim is refused for any reason relating to the merits thereof, the ground of rejection should be fully and clearly stated); see also, Litton Sys., Inc. v. Honeywell, Inc., 140 F.3d 1449, 1459, 46 USPQ2d 1321, 1335 (Fed. Cir. 1998) (the examiner is required, by rules of patent examination, specifically to state the reasons for any rejection). Therefore, it is Applicant's opinion that the Examiner has not properly established, as required by the Manual of Patent Examining Procedure (MPEP), that the receiving chamber of Claim 10 is anticipated by the threaded bore (66) of Monti.

The Examiner also stated that "a recitation with respect to the manner in which an apparatus is intended to be employed, *i.e.* the functional limitation 'for receiving a turnbuckle,' is given only limited patentable weight...." To support his statement, the Examiner cited three court opinions. Apparently, the Examiner attempted to equate the functional limitation "for receiving a turnbuckle" with a recitation with respect to the manner in which an apparatus is intended to be employed so as to establish that the functional limitation should be given limited patentable weight.

Applicant respectfully submits that the functional limitation "for receiving a turnbuckle" is not "a recitation with respect to the manner in which an apparatus is intended to be employed". In re Swinehart defines a functional limitation as an attempt to define something by what it *does* rather than by what it *is*. 439 F.2d at 212, 169 USPQ at 228 (CCPA 1971). The manner in which an apparatus is intended to be employed does not necessarily reveal what the apparatus does. Conversely, what an apparatus does does not necessarily reveal the manner in which the apparatus is intended to be employed. The two are not the same.

Additionally, the three court opinions, cited by the Examiner, do not support the proposition that a functional limitation should be given only limited patentable weight. The first and third opinions (In re Pearson and In re Otto) are not concerned with functional limitations; as a matter of fact, they do not even mention the words "function" or "functional." The second opinion (In re Casey) is concerned with, among others, functional limitations, but it does not support the proposition that a functional limitation should be given only limited patentable weight. If the Examiner disagrees with Applicant's reading of the three opinions, he is invited to point out where in the three opinions his propositions that a recitation with respect to the manner in which an apparatus is intended to be employed is the same as a functional limitation and that a functional limitation is given only limited patentable weight are supported.

Furthermore, the Examiner's position is contrary to the fact that the means-plus-function claim language, which defines a limitation by its function, is given full patentable weight. This also shows that the Examiner's positions are incorrect.

In view of the above discussion, Applicant respectfully requests reversal of the rejection of Claim 10.

IV. The radiused [sic] end portion of the T-slot of Monti cannot be adapted via a T-bolt to the external curvature of a round profile

Claim 11 recites that the end piece of the supporting profile has a concave recess adapted to an external curvature of a round profile. In the embodiment shown in Figure 10, for example, the end piece (24) has a concave recess (25) that is adapted to the external curvature of a round profile (1). This limitation essentially requires that the configuration, such as the radius, of the concave recess (25) matches the configuration of the round profile (1).

Claim 11 was rejected as being anticipated by Monti. In Monti, the end portion (64) of the T-slot (60) in the end cap (46) has a curved configuration (Figure 3). The Examiner contended that the curved end portion (64) of the T-slot (60) is adapted via the T-bolt (82) to the external curvature of a round profile.

In Applicant's opinion, however, the curved end portion (64) of the T-slot (60) is not adapted to the external curvature of a round profile (14), because the radius of the curved end portion (64) is much smaller than that of the round profile (14).

The Examiner also mentioned the T-bolt (82), but it is not clear to Applicant how the T-bolt (82) can help the curved end portion 64 of the T-slot (60) match the external curvature of the round profile (14).

Therefore, Applicant respectfully requests reversal of the rejection of Claim 11, because the curved end portion (64) of the T-slot (60) cannot be adapted to the external curvature of the round profile (14).

V. Monti does not disclose that the clamping assembly is a part of the lower end cap of support member 14B

Claim 13 recites that the end piece has a joint for connection to another profile. In the embodiment shown in Figure 2, for example, the end piece (24) has a joint (11) that can be linked to the joint of another supporting profile so as to link the two supporting profiles.

Claim 13 was rejected as being anticipated by Monti. The Examiner contended that Monti also discloses such a joint, *i.e.* the clamping assembly (28). The clamping assembly (28) of Monti is used to couple the elongate support members (14) to the tripod platform (12) of the photography stand system (see the missing page of Monti; column 6, lines 27-34; and Figures 2 and 11). Since he considered the lower end cap (46) of support member 14B as the end piece, the Examiner, in effect, contended that the clamping assembly (28) is a part of the lower end cap (46) of support member 14B.

Applicant respectfully submits that the clamping assembly (28) of Monti is not a joint as defined in Claim 13, because the clamping assembly (28) is not a part of the lower end cap (46) of support member 14B. There is simply no disclosure in Monti that the clamping assembly (28) and the lower end cap (46) of support member 14B form a single element.

Starting from Claim 10, the Examiner has contended that Monti discloses a supporting profile that includes (1) the upper end cap of support member 14A, (2) the low end cap of support member 14B, and (3) the clamping assembly that is a part of the low end

cap of support member 14B. A fair reading of Monti, however, cannot lead to the conclusion that Monti discloses a supporting profile that includes such a hodge-podge combination of various components of the photography stand system, where some of the components have no disclosed relationships.

In conclusion, Applicant respectfully requests reversal of the rejection of Claim 13, because Monti does not disclose that the clamping assembly (28) is a part of the lower end cap (46) of support member 14B.

VI. Monti does not disclose that the clevis portion of the clamping assembly extends perpendicular to the lower end cap of support member 14B

Claim 14 recites that the joint includes, among others, a first disk which extends perpendicular to the end piece. The meaning of the expression "to extend to" is "to reach." Random House Webster's College Dictionary 472 (1991). In other words, the first disk *reaches* perpendicularly the end piece. In the embodiment shown in Figure 2, for example, the first disk (9) of the joint extends perpendicularly to the end piece (5).

Claim 14 was rejected as being anticipated by Monti. The Examiner contended that Monti also discloses a first disk (*i.e.* the clevis portion (32) of the clamping assembly (28)) that extends perpendicular to the end piece (*i.e.* the lower end cap (46) of support member 14B), where the clevis portion (32) is connected to the tripod platform (12) of the photography stand system (Figures 2, 3, and 11).

Applicant respectfully disagrees. There is simply no disclosure in Monti that the clevis portion (32) of the clamping assembly (28) reaches perpendicularly the lower end cap (46) of support member 14B. In fact, the geometry of the photography stand system makes it impossible for the clevis portion (32) to reach perpendicularly the lower end cap (46) of support member 14B.

Therefore, Claim 14 is not anticipated by Monti. Reversal of the rejection of Claim 14 is respectfully requested.

VII. The combination of Monti and Summers does not teach the use of two hemispheres to cover two sides of two disks

Claim 17 recites that the supporting profile includes first and second hemispheres for covering two sides of the first and second disks.

Claim 17 was rejected under 35 U.S.C. §103(a) as being unpatentable over Monti in view of Summers (U.S. Patent 2,538,483). According to the Examiner, Monti discloses first and second disks, *i.e.*, the clevis portion (32) of the clamping assembly (28) and the projection (30) of the platform (12) (see Figure 2). The Examiner contended that, although Monti does not disclose hemispherical covers, Summers does, and it would have been obvious to use the cover of Summers in Monti because Summers teaches covering unsightly exposed ends of hardware.

Applicant respectfully submits that, for any one of the following two reasons, the combination of Monti and Summers does not teach, as specified in Claim 17, the use of two hemispheres to cover two sides of two disks. The Examiner was correct in stating that Summers teaches the use of caps to cover unsightly exposed ends of hardware. The thumbscrew in Figure 2 of Summers has an exposed end (the upper end) and an unexposed end (a thumb knob at the lower end). Summers teaches covering the exposed upper end of the thumbscrew but does not teach covering the unexposed lower end (the thumb knob) (Figure 2).

Monti also discloses a thumbscrew (34) that extends through the alleged "first and second disks." The thumbscrew of Monti is the same as the thumbscrew of Summers, in that the thumbscrew (34) of Monti has an exposed end and an unexposed end (a thumb knob). Therefore, Summers teaches only the use of a cap to cover the exposed end and does not teach covering the unexposed end (the thumb knob). In other words, Summers does not teach the use of two hemispheres to cover the two sides of two disks, as specified in Claim 17.

Additionally and alternatively, neither side of the Examiner's second disk, *i.e.*, the projection (30) of the platform (12) of Monti, can be covered with a cap, because the Examiner's second disk is inserted into the U-shaped clevis portion (32) and neither side of the second disk is accessible by a cover. Therefore, a person with ordinary skill in the art

would not have covered, indeed could not have covered, a side of the Examiner's second disk with a cover.

In view of the above, Applicant respectfully submits that it would not have been obvious, indeed it would not have been possible, to use the cover of Summers in Monti as specified in Claim 17. Accordingly, Applicant respectfully request reversal of the rejection of Claim 17.

Conclusion

For the foregoing reasons, the rejection of Claims 10-16 as being anticipated by Monti and the rejection of Claims 17 and 18 as being unpatentable over Monti in view of Summers are in error, and the Board is respectfully requested to reverse the rejections.

Respectfully submitted,

September 7, 2004

Song Zhu, Ph.D.
Registration No. 44,420
Donald D. Evenson
Registration No. 26,160

CROWELL & MORING LLP
Intellectual Property Group
P.O. Box 14300
Washington, DC 20044-4300
Telephone No.: (202) 624-2500
Facsimile No.: (202) 628-8844
DDE:SZ:tlm (335855)